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Paper No. 6

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MAY 03 2002

OFFICE OF PETITIONS

In re Application of
Smith & Diaz
Application No.: 09/898,319
Filed: July 2, 2001
Attorney Docket No.: 020699-000310US
For: STORAGE AND RETRIEVAL OF
ENCRYPTED CONTENT ON STORAGE
MEDIA

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed January 30, 2002 (certificate of mailing date December 21, 2001).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on July 2, 2001 without an executed oath or declaration. Accordingly, on August 21, 2001, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on January 30, 2002, a declaration executed by Mr. Smith, the surcharge, a request for a two month extension of time and required fee, the petition fee, and the instant petition were filed. A declaration of facts of Fidel D. Nwamu, an attorney of record, accompanied the petition. Attorney Nwamu explains that non-signing joint inventor, Jose Diaz, was mailed a copy of the above-identified application as filed, including specification, claims, drawings, declaration, and assignment, but the application package was returned to Attorney Nwamu unclaimed.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks item (1).

As to item (1), applicant has failed to establish that Mr. Diaz has refused to sign the declaration or cannot be reached. A successful Rule 47 petition requires either (1) a clear refusal to join,

whether expressly or by conduct, or (2) a showing of diligence in trying to find an unavailable inventor. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events.

The Office requires that the non-signing inventor be provided with a complete copy of the application as filed. Attorney Nwamu's declaration indicates that the mailing to Mr. Diaz was returned unclaimed. This fact alone establishes neither diligence in trying to find the missing inventor, nor the inventor's refusal by conduct to join in the filing of the application. Mr. Diaz may have been on vacation or he may have simply forgotten to pick up his mail. Another copy of the application should be mailed to Mr. Diaz's last known address.

Other attempts to reach Mr. Diaz should be attempted. If the papers are returned, and other attempts to locate the inventor, e.g. through e-mail, computer searches (such as LEXIS), or the telephone continue to fail, then applicant will establish that the inventor cannot be reached.

If it is concluded by the 37 CFR 1.47 applicant that a non-signing inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted.

Further correspondence with respect to this matter should be addressed as follows:

By mail: **Commissioner for Patents**
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
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Telephone inquiries should be directed to the undersigned at (703) 308-6712.

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